



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/877,317	06/17/97	COOK	1515-2508

HM12/0927

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EXAMINER

MARTINELL, J

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

09/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/877,317

Applicant(s)

Cook

Examiner

James Martinell

Group Art Unit

1633



☒ Responsive to communication(s) filed on Jul 2, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-16, 19, 20, and 24-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-16, 19, 20, and 24-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial No. 08/877,317

Art Unit 1633

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

References AO, AP, AT, and BO listed on the form PTO-1449 filed July 2, 1999 have been considered. References AO and AT have been listed by their WO publication document numbers rather than their PCT serial numbers.

Claims 13-16, 19, 20, and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant application does not adequately teach an effect on any organism by administration of any of the modified PNAs mentioned in the claims. This rejection is repeated for reasons already of record (e.g., Office action mailed March 29, 1999, pages 4-5). Rojanasakul is cited here as evidence that antisense treatment of organisms involves several problems, among them, stability of the

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oligonucleotide, uptake of the oligonucleotide, and specificity of hybridization of modified oligonucleotides to their intended targets. The instant application does not address these problems in connection with the administration of an antisense agent to an organism. Applicant's arguments (paper no. 7) are not convincing because applicant does not address any of the potential problems outlined in the rejection.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1633.

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1633 at (703) 308-4242. The faxing of such papers must conform with the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.